



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,004	12/21/2001	Robert R. Gilman	401043-A-01-US	2388

24283 7590 07/01/2005

PATTON BOGGS
1660 LINCOLN ST
SUITE 2050
DENVER, CO 80264

EXAMINER

SZYMANSKI, THOMAS M

ART UNIT	PAPER NUMBER
----------	--------------

2134

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/028,004

Applicant(s)

GILMAN ET AL.

Examiner

Thomas Szymanski

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/17/2002</u> . | 6) <input type="checkbox"/> Other: _____ |

RD

DETAILED ACTION

1. Claims 1-18 have been examined.

Specification

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
3. The applicant is requested to review the specification and update the status of all co-pending applications made mention of, replacing attorney docket numbers with current U.S. application or patent numbers when appropriate. References to U.S. applications or patents should make it clear as to what the number refers (e.g. U.S. Patent No. #), instead of listing only the number.
4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
5. The following title is suggested: Secure data authentication apparatus for the implementation of a feature file.
6. The disclosure is objected to because of the following informalities: The abstract contains the grammatical error "operates" on line 11.
7. The content of the specification is not proper the following sections are missing from the specification

- (f) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward

Art Unit: 2134

the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 4-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claim 4 recites the limitation "The first owner key" in line 21. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-5, 10-14 and 16-17 as best understood are rejected under 35 U.S.C. 102(b) as being anticipated by Chang et al U.S. Patent No. 5,724,425.

Art Unit: 2134

13. Regarding claims 1, 2, and 3: Hashing a file to produce a hash value (Col 7 lines 1-20) a message digest is used to describe the process of hashing the file. Chang et al states that any known message digest algorithm such as MD2, MD4, or MD5 may be used in the creation of the digest. These algorithms hash the file in this same manner as described by the applicant thus providing for a hash value as the resultant.

Encrypting the hash value with a key to generate a signature (Col 7 lines 1-5)

Comparing the generated signature with the original (Fig 6(a, b), Col 9 lines 37-47)

Chang et al states that the file is hashed (i.e. message digest generated) and the signature is decrypted to provide the original hash value. In this manner Chang et al provides for that which is claimed since these are the same thing by way of a logical transitive relationship. Encrypting the newly generated hash value and comparing that to the provided signature is logically the same as decrypting the original signature and comparing that to the produced hash value.

File is authenticate if signatures match (Col 9 lines 45-46)

14. Regarding claims 4-5 and 10: upon verification of the file replacing the first with the second. (Col 8 lines 8-16, 58-59, Col 25 lines 27-56) Chang et al states that the code associated by the signature can take the form of any type of data. As such upon the authentication of such data it would be necessary to store or act accordingly to the data type. The execution of pure data in the form of a key for example would only be feasible for storage or overwriting of pre-existing data as such anticipating the above claim.

Art Unit: 2134

15. Claims 11-14, 16-17 are a method implementation of the above rejected claims and as such are rejected upon the same basis.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 6-9, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al U.S. Patent No. 5,724,425 as applied to claim 1 above, and further in view of Horstmann U.S. Patent No. 6,044,469.

18. Regarding claims 6 and 7: Chang et al has taught the method of authentication as in claim 1 above but fails to teach the implementation of a feature file.

19. Horstmann, however, teaches the use of such a file to provide for functionality of subsets of the product.

20. A plurality of features wherein a subset of the features is activated based upon the prescribed licensed features. (Horstmann Fig 6, Col 3 lines 39-44, Col 5 lines 54-65) Horstmann's system of software protection allows for implementation of subsets of a products full functionality as described.

21. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to combine the authentication methods of Chang et al with the functionality of partial licensing as denoted by Horstmann. As it may be seen

Art Unit: 2134

(Horstmann Col 2 lines 14-27) one would be motivated to combine these two systems for added flexibility of ease of configuration of software features and the ability to maintain security while giving the user further convenience as stated by Horstmann, thus making this a desirable combination.

22. Claims 16 and 18 are a method implementation of the above rejected claims and as such are rejected on the same basis.

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of art disclosed by the references cited and the objections made. Applicant must show how the amendments avoid such references and objections. See 37 CFR 1.111(c).

24. Inquiries concerning this communication or earlier communications from the examiner should be directed to Thomas M. Szymanski who can be reached at (571) 272-8574. The examiner's normal working schedule is between the hours 8:00am – 4:30pm (EST), Monday – Friday.

25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse, can be reached at (571) 272-3838. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

26. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

Art Unit: 2134

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.


For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

JL

David Y. Jung
Primary Examiner


6/25/08